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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,796	09/28/2001	Maximilian Angel	0050/51796	2868

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EXAMINER
REDDICK, MARIE L

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/964,796	Applicant(s) ANGEL ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover she t with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> *The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "one of more compounds of the formula (A) or (B) with R^1 = H, C1-C6-alkyl — or mixtures thereof" per claim 1 constitutes indefinite subject matter as per there being no structural formula, representative of formula (A) and (B), depicted and, as such, engenders the non-establishment of proper antecedent basis for the latter part of the phrase.

B) The recited "at least one other polymerizable monomer selected from acrylic and methacrylic acids are crotonic acid—and N-vinyllactams" per claim 1 constitutes indefinite subject matter as per a) it is not readily ascertainable as to how said "other further polymerizable monomer" further limits the antecedently recited "monomer mixture", i.e., it is not clear if the optional "other polymerizable compounds (C)" are being defined or else; b) the recited "acrylic and methacrylic acids are crotonic acid" engenders an ambiguity; c) said phrase houses improper Markush language, use of "selected from the group consisting of" is proper and is suggested.

C) The recited "wherein the compounds of the formula (A)" per claim 4 and "wherein the compounds of the formula (B)" per claim 5 constitute indefinite subject matter as per the non-express establishment of proper antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless –*
>
> *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Armour(U.S. 3,433,701, as applied to claims 1-6 and 8) or Bergmeister et al(U.S. 3,817,896, as applied to claims 1-8).

Armour discloses adhesive compositions, useful in the bonding, saturation or lamination of a variety of porous substrates such as wood and related products, and defined as containing a stabilized, aqueous vinyl acetate copolymer emulsion wherein, the stabilized vinyl acetate copolymer emulsion is produced via emulsion polymerizing vinyl acetate with at least one comonomer which includes hydroxyalkyl esters of alpha, beta-unsaturated carboxylic acids(in an amount of about 20 wt.%), in an aqueous medium and in the presence of a free-radical initiating catalyst and a hydrocolloid emulsifier, viz., polyvinyl alcohol, in a content of about 2 to 12 wt.%, based on the weight of total monomer charge. Armour discloses @ col. 3, lines 19-35 that the use of the polyvinyl alcohol, in the emulsion polymerization, serves to enhance the stability of the resulting emulsion. See, e.g., the Abstract, cols. 3-5, Runs I and II and the claims of Armour.

Bergmeister et al disclose stable, aqueous copolymer dispersions of ethylene and vinyl acetate governed by a solids content of up to 70 wt.%, useful in forming adhesives, paint binders, etc., prepared via aqueous emulsion polymerization in the presence of a redox catalyst, protective colloids and/or emulsifiers wherein up to 40 wt.% of the vinyl ester can be replaced with hydroxyalkyl esters and wherein the protective colloid, in an amount expressed per at least Run 1 falling within the scope of the claims, includes polyvinyl alcohol(see, e.g., the Abstract and cols. 5-6 of Bergmeister et al). More specifically, Bergmeister et al @ col. 5, lines 36-44 teaches that the aqueous copolymer dispersions are suitable as binder adhesives, coating materials on a variety of substrates, soil improving agents, etc.

Each of Armour and Bergmeister et al therefore anticipate the instantly claimed invention with the understanding that the components per each of Armour and Bergmeister et al overlap in scope with the components of the instantly claimed invention, in both content and character and that the "about 12 wt.% of polyvinyl alcohol per Armour is sufficient to meet the content of polyvinyl alcohol per the claimed invention

since "about" is relative and not absolute. Even if this turns out not to be the case, it would have been obvious to the skilled artisan, following the guidelines of Armour @ col. 3, lines 19-35, to increase the content of polyvinyl alcohol(hydrocolloid emulsifier) and with a reasonable expectation of success. Further, the use of the compositions of Armour and Bergmeister in the coating of a pharmaceutical dosage form is tenable since the composition of each of Armour and Bergmeister et al is essentially the same as and made under essentially the same conditions as the claimed copolymer.

As to the dependent claims, the limitations are either taught by Armour and Bergmeister et al, suggested by Armour and Bergmeister et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.

As to the "consisting essentially of" clause, such limits the scope of a claim to the specified ingredients and to those that do not materially affect the basic and novel characteristics of a composition(Ex parte Davis, 80 USPQ 448 and In re Janakirama-Rao, 317 F 2d 951, 137 USPQ 893, CCPA 1963).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

7. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. *Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Armour(U.S. 3,433,701).*

The disclosure of Armour for what it teaches and as applied to claims 1-6 and 8 is as stated in the paragraph 5 supra. Further, the disclosure of Armour differs basically from the claimed invention as per the amount of hydrocolloid emulsifier(polyvinyl alcohol) authorized is slightly less than the amount recited per the claimed invention. However, following the guidelines of Armour @ col. 3, lines 19-35, one having ordinary skill in the art would have found it obvious, on its face, to increase the amount of hydrocolloid emulsifier and with a reasonable expectation of enhancing the resulting emulsion stability. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record.

Response to Arguments

10. *Applicant's arguments filed 05/14/03 have been fully considered but they are not persuasive.*

Relative to the 112, 2nd paragraph issues— While Counsel, in a good faith effort, attempted to remedy the 112 issues raised in the previous Office Action(12/19/02, paper no. 5), some still remain and new issues were created as set forth supra.

Relative to Armour—The crux of Counsel's arguments appears to hinge on the ratio of vinyl acetate:hydroxyethyl methacrylate being 80:20 to 100:0 and to this end, the claims in their present form do not preclude the "vinyl acetate" component of Armour and the content of hydroxyethyl methacrylate overlaps in scope with the claimed monomer component a).

Relative to Bergmeister et al—It is urged and maintained that the claimed invention(1-8) is anticipated by or obvious over Bergmeister et al as per reasons of record not rebutted by Counsel.

Counsel is herein apprised that a rejection in the future can be precluded by replacing "selected from the group of — or mixtures thereof" per claim 4 and "selected from the group of" per claim 5 with "selected from the group consisting of— and mixtures thereof" per claim 4 and "selected from the group consisting of" per claim 5. A rejection is not being made at this time since the outstanding rejections still appear valid.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
July 22, 2003